

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Markus KORDES et al.

Mail Stop: Amendment

U.S. Application No. 10/583,710

Confirmation No. 3247

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International Application No.: PCT/EP2004/014623

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Examiner: Golam M. Shaheem

Title: 1-(Azolin-2-yl)amino-1,2-diphenylethane  
Compounds for Combating Insects, Arachnids and  
Nematodes

Group Art Unit: 1626

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In complete response to the Restriction Requirement mailed December 30, 2008, Applicants elect Group I, Claims 20-34 and 37, drawn to a compound of formula I, wherein A is A<sup>1</sup> for prosecution in the present application. Applicants further elect the compound of Example 70 as a species (Table 1 at page 73 of the specifications). The compound of Example 70 corresponds to the compound of Formula I wherein (R<sup>1</sup>)<sub>n</sub> is H, (R<sup>2</sup>)<sub>n</sub> is 2-Cl and 3-Cl, each of R<sup>3</sup>, R<sup>4</sup>, R<sup>5a</sup>, R<sup>5b</sup>, R<sup>5c</sup>, and R<sup>5d</sup> is H, X is S, and R<sup>6</sup> (when A is A<sup>1</sup>) or R<sup>7</sup> (when A is A<sup>2</sup>) is H. Applicants note that when R<sup>6</sup> is H, the moiety A<sup>1</sup> is a tautomer of the moiety A<sup>2</sup> where R<sup>7</sup> is H. Claims 20-24, 26-28, 30-33, and 35-37 read on the elected species. Applicants reserve the right to file divisional application(s) based on the non-elected claims.

Applicants respectfully **traverse** the Restriction Requirement.

The Examiner restricts the claims to Groups I-V because "each relate to a set of structurally diverse and dissimilar compounds and their method of use which do not possess a substantial common core wherein a reference anticipating one would not necessarily render the other obvious." Office Action, pages 3-4. Applicants disagree.

The Restriction is traversed for the following reasons. 37 C.F.R. § 1.475(a) states that unity of invention is fulfilled if there is a technical relationship among those inventions

involving *one or more* of the same or corresponding special technical features. The expression "special technical features" is defined as those technical features that define a contribution which each of the claimed inventions, *considered as a whole*, makes over the prior art.

***Groups I and II Share 1,2-Diphenylethane Substituted with N-bound Azolin-2-ylamino***

Applicants assert that Groups I and II share the common technical core structure of 1,2-diphenylethane group substituted with N-bound azolin-2-ylamino moiety A<sup>1</sup> or A<sup>2</sup> on the ethane bridge. The (1-azolin-2-yl)amino moieties A<sup>1</sup> and A<sup>2</sup> of claims 20-37 are structurally related because when R<sup>6</sup> is H, the moiety A<sup>1</sup> is a tautomer of the moiety A<sup>2</sup> where R<sup>7</sup> is H. Based on the common technical feature and the absence of a reference that destroys the unity of invention of Groups I and II, the two groups have unity of invention. Applicants respectfully request reconsideration and withdrawal of the restriction between the two groups.

***Group III is Drawn to a Method of Use of Compounds of Claim 20***

Under 37 CFR 1.475 (b), "a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn . . . to [a] product and a process of use of said product." The method claims of Group III use the compounds of claim 20 (now restricted to Groups I and II). Therefore, the method claims of Group III have a unity of invention with the compound claims of Groups I and II. Reconsideration and withdrawal of the Restriction requirement is respectfully requested.

***Groups IV and V are drawn to Intermediate compounds for the Synthesis of Compounds of Claim 20***

The compounds of formulae V and Va are intermediates in the preparation of the compounds of formula I with X=S (compound V) or X=O (compound Va). Both compounds are structurally related to the compound of formula I because a simple cyclocondensation of either compounds of formulae V and Va leads to the formation of a compound of formula I. Moreover, a large portion of compounds of formulae I, V and Va is occupied by a substituted 1,2-diphenylethane group, which defines a contribution which each of the claimed inventions of Groups I, II, IV, and V, *considered as a whole*, makes over the prior art. Reconsideration and withdrawal of the Restriction requirement is respectfully requested.

Based on the foregoing, Applicants respectfully request that the Restriction Requirement be reconsidered and withdrawn.

**Although it is believed that no fee is necessary, the Director is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 23-1925.**

If any questions remain, the Examiner is invited to contact the undersigned at the number given below.

Respectfully submitted,

BRINKS HOFER GILSON & LIONE

Date: January 29, 2009

By: \_\_\_\_\_



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